

IN PROCESS REVIEW

Application Number 09/780,279	Art Unit 3764	Rejection Mail Date 20-Nov-03	Examiner MATHEW, FENN
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Rejections Made

The office action contains rejections made under the following statutes:

- 35 U.S.C. 102
- 35 U.S.C. 103
- 35 U.S.C. 112, first paragraph, written description
- 35 U.S.C. 112, first paragraph, enablement
- 35 U.S.C. 112, second paragraph
- 35 U.S.C. 101 (utility)
- 35 U.S.C. 101 (non-statutory subject matter)
- Double Patenting (statutory, ODP)
- Other (e.g., Best Mode)

No Error
Spam
OPQA

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Omitted Rejections

Is there a potential clear error for omitting a rejection? (The rejection you propose must be reasonable)

Yes No

If yes, check all that apply

- 35 U.S.C. 102
- 35 U.S.C. 103
- 35 U.S.C. 112, first paragraph, written description
- 35 U.S.C. 112, first paragraph, enablement
- 35 U.S.C. 112, second paragraph
- 35 U.S.C. 101 (utility)
- 35 U.S.C. 101 (non-statutory subject matter)
- Double Patenting (statutory, ODP)
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Section III. 35 U.S.C. 102**Correctness of 35 U.S.C 102 Rejections**

Were all 35 U.S.C 102 rejections reasonable?

(No indicates potential clear error)

If no, indicate the problem (check all that apply)

- Claimed features not found in the reference.
 Wrong subsection of 35 U.S.C. 102 used.
 Date of the reference no good.
 Inherency applied improperly.
 Improper official notice.
 Other

Comments:

Claims 2-3, 5-9, 12, 13, 15, 18-21, 36-38 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuervers (U.S. 4,938,477). However Kuervers does not specifically teach that pad 25 (col. 3, lines 23-25) is compressible and therefore cannot anticipate independent claims 6, 12, 19 and 36. Pads 22 ARE described as being formed from foam and one could fairly infer that it would be OBVIOUS that pad 25 also be formed from foam. Also, Kuervers does not teach the pressing of the user's body against the pad or compressible layer as recited in method claims 36-38 and 40. The invention of Kuervers is attached at the wrist of the user but is designed to minimize pressure on the user's wrist in order not to impede blood flow through the wrist area (see col. 3, lines 43-49). The device is held in place by a clasp 17 and the user's fist.

Clarity of 35 U.S.C 102 Rejections

Were all 35 U.S.C. 102 rejections formulated in a clear manner?

 Yes No**(No indicates potential clear error)**

Were claim limitations matched to the art?

 Yes Sometimes No

Was any statement of inherency clearly explained?

 Yes Sometimes No N/A

Comments:

In paragraph 23 of the Office action claim 39 was omitted although was clearly intended to be included in the 102(b) rejection over Evans. See paragraph 28. Also, the examiner rejects claim 39 under 102(b) over Evans by stating that the reference discloses pressing the user's ARM against the first surface. However claim 39 calls for pressing the user's LEG against the first surface.

35 U.S.C 102 Rejection(s) That Should Have Been Made

Give a brief description of the proposed 35 U.S.C. 102 rejections(s) that should have been made:

Origin of Prior Art used in the proposed 35 U.S.C. 102 rejection(s) above

- of record
 not of record (attach search logic/documentation)

 East EPO Other West JPO NPL Derwent

Comments:

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Section III. 35 U.S.C. 103**Correctness of 35 U.S.C 103 Rejections**

Were all 35 U.S.C 103 rejections reasonable?

 Yes No**(No indicates the presence of a potential clear error)**

If no, indicate the problem (check all that apply)

- Claimed features not found in the reference.
- References not combinable.
- Date of the reference no good.
- Improper motivation.
- No reasonable expectation of success.
- Improper Official Notice taken.
- Other

Comments:

The 103 rejections which rely on Kuervers must be considered unreasonable because they depend on an improper 102 rejection based on Kuervers (see discussion in the 102 section).

Clarity of 35 U.S.C 103 Rejections

Were all 35 U.S.C. 103 rejections formulated in a clear manner?

 Yes No**(No indicates potential clear error)**

Were claim limitations matched to the art?

 Yes Sometimes No

Were the differences clearly stated?

 Yes Sometimes No

Was the modification or combination of references clearly explained

 Yes Sometimes No

Was the motivation/reasons for obviousness present?

 Yes Sometimes No

Comments:

No "obvious" statement in paragraph 30 of the Office action.

35 U.S.C 103 Rejection(s) That Should Have Been Made

Give a brief description of the 35 U.S.C. 103 rejection(s) that should have been made:

Origin of Prior Art used in the proposed 35 U.S.C. 103 rejection(s) above

- of record
- not of record (attach search logic/documentation)

 East EPO Other West JPO NPL Derwent

Comments:

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SECTION XI. File Wrapper**Reasons for Allowance (R/A)**

Did the Examiner write a Reasons for Allowance (R/A)?

 Yes No N/A

If yes,

Is the R/A clear and complete?

 Yes No

If no,

Does the record as a whole indicate a R/A was necessary?

 Yes No

Comments:

Interviews

Was there an interview regarding the merits of the case relevant to the action reviewed?

 Yes No

If yes,

Was Summary Form PTOL-413 completed?

 Yes No

Is the record of the interview clear and complete?

 Yes No

Comments:

ClaimsWere claims treated in an inappropriate manner on non-substantive issues? Yes No

If yes,

 claims are present that were not addressed. claims previously withdrawn from consideration should have been cancelled. improper dependent claims were not properly treated. other

Comments:

Sequence Rules

Does the application contain nucleotide and/or amino acid sequences?

 Yes No

If yes,

Did the examiner properly handle Sequence Compliance Issues?

 Yes No

Comments:

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Section XIII. Other Issues

Were all claims for priority properly treated? Yes No N/A

If a restriction was made, was it proper? Yes No N/A

Were all matters of substance in applicant's response and affidavits/declarations evaluated sufficiently? Yes No N/A

Other issues? Yes No

An IDS statement filed August 23, 2002 should be completed. (see rear of right side in file wrapper).

Comments:

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Section XIV. Indicia of Commendable/Outstanding		
Patentability Determination: Indicia of Commendable/Outstanding		
The record developed by the examiner shows an indication of allowable subject matter at the earliest time which is consistent with the file record and prosecution of the application.		<input type="checkbox"/> Yes
Through the rejections and arguments made by the examiner, an appropriate line of patentability is established which results in amendment(s) properly limiting the scope of an		<input type="checkbox"/> Yes
The search record in the application clearly shows that the examiner construes the claimed subject matter in its broadest reasonable interpretation and seeks to develop prior art from the appropriate peripherally related art areas.		<input type="checkbox"/> Yes
Action Taking: Indicia of Commendable/Outstanding		
The statements of rejection, objection, and response to arguments clearly and concisely present the positions taken or recommended in the resulting Office actions including a thorough substantive explanation to convey those positions to the applicant.		<input type="checkbox"/> Yes
The Office action usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken.		<input type="checkbox"/> Yes
The Office action indicates that the principle of compact prosecution is being fully followed. Note, the principle of compact prosecution comprises conducting an initial search which is as complete as possible including consultation with an expert in the art where the examiner lacks such expertise (see search guidelines); placing art of record which meets both the concept and the wording of the claims as well as other art which is pertinent to significant though unclaimed features of the disclosed invention; and issuing a first Office action which clearly explains the examiner's position on each essential issue in such detail that absent some unexpected consideration the next Office action may be made final.		<input type="checkbox"/> Yes
Patent Examining Function: Indicia of Commendable/Outstanding		
Check one of the following statement if applicable:		
<input type="checkbox"/> The Office action is formulated to advance the prosecution, correct other informalities, and develop a complete file wrapper record. The Office action also is such that it leaves little room for improvement. The Office action clearly and concisely presents the positions taken.		
<input type="checkbox"/> The entire Office action is complete and accurate and does not require any substantial revision. The Office action effectively conveys the positions taken.		
Comments:		

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11/20/03

Examiner

MATHEW, FENN

Section XII. "X" Actions

- 1- Clearly wrong 102 or 103 such that a claimed feature(s) from an independent or dependent claim is not taught and no other appropriate art rejection of that claim was made

If Yes

- Independent claim(s) only
 Dependent claim(s) only
 Both dependent and independent claim(s) only

- 2- No motivation statement in a 103 rejection

If Yes

- Independent claim(s) only
 Dependent claim(s) only (only check this if the motivation for the independent claim(s) would not cover the dependent claim(s))
 Both dependent and independent claim(s)

- 3- "Shotgun" 102 or 103 rejection that deals with all claims in that rejection

- 4- Clearly incomplete actions including restrictions

- 5- The action copied (or substantiall copied) the prior office action with no response to substantive arguments made by applicants either in response to the previous action's rejection or restriction

- 6- A 131 or 132 affidavit or declaration was not treated

- 7- An overly broad claim found during a review of allowed or allowable claims, or allowable subject matter, using a 2nd pair of eyes standard

- 8- Either a lack of utility under 101 or lack of enablement or writen description under 112 1st

Comments:

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Search		
Initial Data Capture Points		
Was art provided from an ESS before first action?	<input type="radio"/> Yes <input type="radio"/> No	
Was any IDS improperly treated?	<input checked="" type="radio"/> Yes <input type="radio"/> No <input type="radio"/> N/A	
Was a text search performed by the Examiner?	<input type="radio"/> Yes <input checked="" type="radio"/> No	
Was it non-patent literature?	<input type="radio"/> Yes <input type="radio"/> No	
Is the search strategy printout present?	<input type="radio"/> Yes <input type="radio"/> No <input checked="" type="radio"/> N/A	
Was the inventorship searched by the Examiner?	<input type="radio"/> Yes <input checked="" type="radio"/> No	
If any TC or specialized art has identified specific search requirements in addition to or in exclusion of the above requirements, were these specific requirements complied with?	<input type="radio"/> Yes <input type="radio"/> No <input checked="" type="radio"/> N/A	
Were foreign patent documents cited by the Examiner on an 892?	<input type="radio"/> Yes <input checked="" type="radio"/> No	
Were NPL documents cited by the Examiner on an 892?	<input type="radio"/> Yes <input checked="" type="radio"/> No	
Did the Examiner perform a new search in a 2nd/subsequent action?	<input type="radio"/> Yes <input checked="" type="radio"/> No <input type="radio"/> N/A	
Did the Examiner update all searches in a subsequent action?	<input type="radio"/> Yes <input checked="" type="radio"/> No <input type="radio"/> N/A	
Did an ESS submit a new search report in a 2nd/subsequent action?	<input type="radio"/> Yes <input type="radio"/> No <input type="radio"/> N/A	
Was there new art found by the Examiner that was applied in a 2nd/subsequent action?	<input checked="" type="radio"/> Yes <input type="radio"/> No <input type="radio"/> N/A	
Has a search been performed by the Reviewer?	<input type="radio"/> Yes <input checked="" type="radio"/> No	
Overall Rating of the Search		
<input checked="" type="radio"/> Adequate <input type="radio"/> Less than Adequate		
Comments:		